

REMARKS

This amendment is responsive to the communication of December 4, 2002. Reconsideration of claims 2-15 and 17-39 are respectfully requested.

The Office Action

Claims 1, 3, 4, 6, 12, 13, 16, 17, 21, and 22 stand rejected under 35 U.S.C. § 102 as being anticipated by Himes (US 6,332,891).

Claims 8, 15, 23-29, and 38 stand rejected under 35 U.S.C. § 112, second paragraph.

Claims 2, 5, 7, 9-11, and 20 were indicated as containing allowable subject matter.

Claims 31-37 and 39 stand allowed.

The Drawings

The Examiner notes that reference number 64 does not appear in FIGURE 1. Reference number 64 is used in conjunction with an imaging device, such as a CT scanner, a magnetic resonance scanner, or the like. The imaging device 64 does not appear in FIGURE 1. The imaging device 64 appears in FIGURE 3 and is described in conjunction with FIGURE 3 in the last paragraph of page 9.

37 CFR 1.84(b)(5) requires that reference characters mentioned in the description must appear in the drawings. It does not require the reference numbers to appear in all drawings. Because reference character 64 does appear in FIGURE 3, it is submitted that the drawings are in compliance with the rules.

35 U.S.C. § 112

Claims 8, 15, 23, and 38 have been carefully amended to address the points raised by the Examiner. With this amendment, it is submitted that all drawings now comply with the requirements of 35 U.S.C. § 112.

The Present Amendment

Claim 1 has been cancelled and claims 2, 5, 7, 9, 10, and 11, which were indicated as containing allowable subject matter, were placed in independent form. Claims 3, 4, 6, 8, and 12-15 were each amended to depend from one of the allowable dependent claims which were placed in independent form. Accordingly, it is submitted that claims 2-15 are now in condition for allowance.

Claim 16 has been cancelled. Claim 20, which was indicated as containing allowable subject matter, has been placed in independent form. Claims 17-19, 21, and 22 have been amended to depend from claim 20. Accordingly, it is submitted that claims 17-22 are now in condition for allowance.

Claim 23, which was rejected under 35 U.S.C. § 112 but not on prior art, has been amended to resolve the 35 U.S.C. § 112 issues. Accordingly, it is submitted that claim 23 and claims 24-29 dependent therefrom distinguish patentably and unobviously over the references of record.

Claim 30 has been amended to be more similar to allowable claim 2. In particular, claim 30 has been amended to emphasize that the graphics processor is only preprogrammed with software that provides limited functionality and that the digital media is programmed with software which upgrades the preprogrammed software to full user functionality for the identified surgical procedure. This concept is not shown or fairly suggested by Himes. Himes fails to teach or fairly suggest a kit which includes software for upgrading the software of another computer. Accordingly, it is submitted that claim 30 is now in condition for allowance.

Claims 31-37 stand allowed.

Claim 38 has been amended to address the language to which the Examiner objected under 35 U.S.C. § 112. With this amendment, it is submitted that claim 38 now complies with the requirements of 35 U.S.C. § 112. There being no outstanding rejection on art, it is submitted that claim 38 is now in condition for allowance.

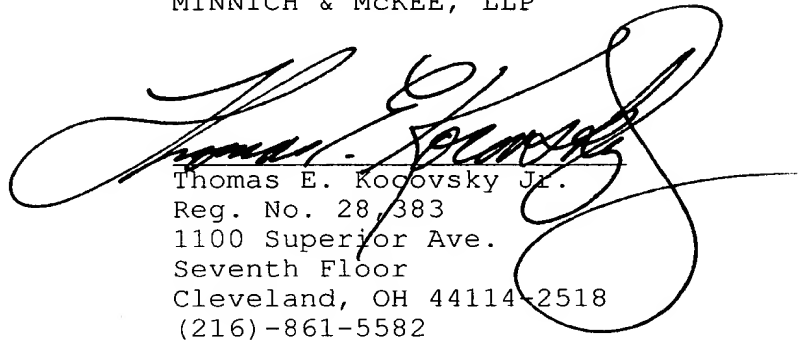
Claim 39 stands allowed.

CONCLUSION

For the reasons set forth above, it is submitted that claims 2-15 and 17-39 (all claims) are now in condition for allowance. An early allowance of all claims is requested.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP



Thomas E. Kocovsky Jr.
Reg. No. 28,383
1100 Superior Ave.
Seventh Floor
Cleveland, OH 44114-2518
(216)-861-5582

CERTIFICATE OF MAILING

I hereby certify that this **AMENDMENT B** in connection with U.S. Patent Application Serial No. 09/978,599 is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on this 4th day of March, 2003.

By: Hilary McNulty